

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (a) the inventions must be independent or distinct as claimed; and
- (b) there must be a serious burden on the examiner if restriction is required. *Id.*

Applicant respectfully submits that the Examiner has not properly established distinctness to support a basis for restriction between the inventions in Group I (claims 1-9) and the inventions in Group II (claims 10-18) for the reasons discussed in the response filed on 7/29/02. Accordingly, all system claims 1-18 should be examined on the merits.

For the foregoing reasons, Applicant submits that the Restriction Requirement of Groups I and II is improper and respectfully requests the Examiner to reconsider and withdraw the same.

B. RESTRICTION OF SPECIES.

The Examiner further alleges the application further contains claims directed to a plurality of disclosed and "patentably distinct" species as follows:

Species I: Figs. 1, 2 and 9-12;

Species II: Fig. 3;

Species III: Figs. 4 and 5;

Species IV: Figs. 6 and 7;

Species V: Fig. 8;

Species VI: Fig. 9¹;

Species VII: Fig. 10;

Species VIII: Figs. 13-14.

However, as discussed in the previously filed response to the requirement for election of species, the Examiner has not provided any indication, and Applicant is unsure, of the features that the Examiner believes renders the cited figures as containing patentably distinct species. Notwithstanding, the Examiner, in the second Office Action mailed on 11/19/2001, continues to require election of the same species without any further explanation as requested by Applicant.

¹ This figure is also referenced by the Examiner as part of Species I.

Consequently, Applicant is still unable to make an informed election of claims based on the options presented by the Examiner. By way of example, Figs. 13 and 14 (Species VIII) illustrate the treadmill 214 shown with all the other alleged species in Figs. 2, 3, 5, 7 and 10, while Figs. 11 and 12 (Species I) illustrate the bench 202 and corresponding enclosure 104 shown with all of the other alleged species in Figs. 2, 3, 5, 7 and 9. Moreover, Fig. 8 illustrates a detailed example of enclosure 104 depicted in all of Figs. 1-7 and 11-12. Since items 214, 204 and 104 are reflected in all the Figures and only one type of each item is shown and described in the application, there are no several species shown and consequently no way for Applicant to differentiate claims related to Species V-VIII as opposed to Species I-V. Claims to be restricted to different species must be mutually exclusive. (See MPEP 806.04(e)-(f)).

Since the Examiner has not identified any mutually exclusive species in the requirement for election, the Examiner has not shown a *prima facie* requirement for restriction. Accordingly, the requirement must be withdrawn.

In the Response filed on 7/29/02, Applicant identified the following potential species shown in the application figures as follows:

Species 1: Figs. 1 & 2 a system having two exercise modules (e.g., a treadmill and a weight bench) and a bookcase or other third module formed in a straight line;

Species 2: Fig. 3 including a system having more than three modules formed in a "U" shape including two exercise modules (e.g., a treadmill and a weight bench);

Species 3: Figs. 4 and 5 including a system having multiple modules including two exercise modules (e.g., a treadmill and a weight bench) and a work surface; and

Species 4: Figs. 6 and 7 including a system having two exercise modules (e.g., a treadmill and a weight bench) in a back-to-back position and a work surface.

Applicant further identified the following claims as readable on Applicant-identified Species 1-4:

Claims 1, 2, 3, 5, 6, 7, 8, 9, 10, 11, 14, 15, 16, 17 and 18 are generic to all Applicant-identified species;

Claims 4 and 12 are directed to Species 3; and

Claim 13 is directed to Species 4.

1. Election of Applicant-identified Species 3 with Traverse.

Should the Examiner adopt the applicant-identified species, **Applicant hereby elects species 3, directed to claims 1-12 and 14-18, with traverse.**²

2. Arguments Traversing Species Restriction.

“Every requirement to restrict has two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claims are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.” (MPEP 808, 816). In the Office Action mailed on June 27, 2002 **and the Office Action mailed on 11/19/2002**, the Examiner did not provide any reasoning or even a conclusory statement why the identified species are either independent or distinct; nor has the Examiner demonstrated why examining the limited number of species would present a serious burden. It is respectfully submitted that there would be no “serious burden” on the Examiner to examine all of Applicant’s claims. Moreover, since non-elected claim 13 depends from elected claim 12, and in turn from generic claim 10, examination of these claims should yield any pertinent art in respect to claim 13. In any event non-elected claim 13 would be subject to reinstatement upon allowance of claims 10 and/or 12.

For the foregoing reasons, Applicant respectfully submits the Species Restriction is improper and respectfully requests that it be withdrawn.

C. CONCLUSION.

In response to the related invention restriction, Applicant elected claims 10-18 with traverse. In response to the species restriction Applicant elected claims 1-12 and 14-18 with traverse. If, however, both requirements should be made final, and upon confirmation of any finality of these requirements by petition to the Commissioner, claims 10-12 and 14-18 would be the remaining elected claims to be examined fully on the merits.

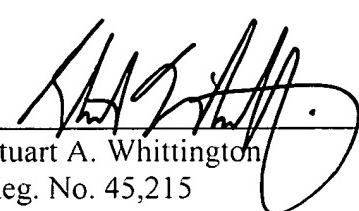
² If the Examiner does not adopt the applicant-identified species, the Examiner is respectfully requested to re-issue the requirement for election of species and identify the features shown in the claims which are mutually exclusive.

Reconsideration and withdrawal of both requirements for restriction are respectfully requested. If there are any issues that may be resolved by a telephone call, the Examiner is kindly requested to contact the undersigned. Any fees, or deficiency thereof, required to maintain the pendency of this application are hereby authorized to be charged to **Deposit Account No. 19-3878.**

Respectfully submitted,

12/19/02
Date

By


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